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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,183	07/08/2003	Erin Jessica Lindsay	033528-001	7109

7590 10/17/2006

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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EXAMINER
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FOSTER, MARLEE CHRISTINE

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/614,183

Applicant(s)

LINDSAY, ERIN JESSICA

Examiner

Marlee C. Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant cancelled claim 2 and added claims 12-14 in the amendment filed September 28, 2006. As a result, claims 1 and 3-14 remain currently pending in the application.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 3, 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayer (US 2004/0204725) in view of Agee et al. (US Patent 5,306,284). Bayer discloses a surgical apparatus with an endoscopic barrel with two or three lumen (see figures 3, 10, and 11), instruments disposed through the lumen, a handle disposed at the proximal end for controlling the device, and a conical distal tip. Bayer discloses one or more instruments extendable through each of the lumen of the device including cutting, suction, and manipulating instruments (shown as 134a and 134b), however, the conical tip must be displaced to access these instruments.

Agee et al. teaches a similar instrument with a concave distal tip, and a cutting device pivotally extendable through the distal tip via a recess (13). When the cutting

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device is held in a retractable state, the contoured profile of the distal portion of the instrument is maintained, to minimize the risk of injury to the surrounding tissues.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Bayer in view of Agee et al. by making the manipulator and cutting instruments extendable through the conical tip, eliminating the need to remove the conical tip and reducing the risk of injury to the surrounding tissue.

4. Claims 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayer (US 2004/0204725) in view of Haber et al. (US Patent 5,282,806). Bayer discloses the rotatable control assembly disposed on a track on the handle, used for actuating rotational and translational movement of the tip and shaft of the instrument (paragraph 0077). Haber et al. disclose an endoscopic instrument with a manipulator fork comprising a distal fork and a fork arm. The handles on Haber's instrument actuate rotational movement, or swiveling, of the fork, as well as movement of the distal jaws of the manipulator (col. 4, lines 37-65). The swivel control tube (8) causes the manipulator to rotate when the handles are engaged. Bayer discloses the use of various endoscopic instruments with his device, such as the instrument of Haber et al. Therefore, it would have been obvious to one of ordinary skill in the art to use the instrument of Haber et al. in the device of Bayer.

5. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayer (US 2004/0204725) in view of Agee et al. (US Patent 5,306,284). Bayer discloses an endoscopic instrument with a barrel, a handle disposed at the proximal end of the barrel, and a cone portion with a shaft including three lumen. Bayer shows, in

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figures 10 and 11, that one manipulator fork is extendable through each lumen in the shaft of the instrument. Two manipulator forks may be used. However, Bayer does not show a manipulator fork or cutting device extendable *through* the cone portion of the instrument, necessitating removal of the conical distal tip of the instrument.

Agee et al. teaches a surgical instrument with a concave tip, through which a cutting device is pivotally extendable through a recess in the probe. (See figures 1, 3, and 4). The cutting device is retractable to enable the probe to be properly positioned within the tissues prior to cutting, thus minimizing the risk of trauma to surrounding tissues. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Bayer in view of Agee et al. by making the manipulator and cutting instruments extendable through the conical tip, eliminating the need to remove the conical tip and reducing the risk of injury to the tissue.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1 and 3-14 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marlee C. Foster whose telephone number is (571) 272-5072. The examiner can normally be reached on Monday to Friday 8:00AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Marlee C. Foster*

MCF  
10/13/06

  
ANH TUAN T. NGUYEN  
SUPERVISORY PATENT EXAMINER

*10/15/06*